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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/619,391 07/19/00 SCHERTLER R 622/40901C2

QM32/1010
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EXAMINER

JIMENEZ, M

ART UNIT

PAPER NUMBER

3726

4

DATE MAILED:

10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/619,391

Applicant(s)

SCHERTLER, ROMAN

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-72 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 35-72 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Reissue Applications

1. **Claims 35-72** are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

Claim 35 recites "draft shaft" in lines 8 and 11.

Claim 37 recites "draft shaft" in line 2.

Claim 52 recites "draft shaft" in lines 3 and 4.

2. Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,245,736, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

3. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414.

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The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The oath/declaration filed with this application is not consistent with the claims pending. For instance, the oath/declaration makes reference to claims 1, 16, 30, 32, 33, and 34 which are not currently pending in the instant re-issue application.

The oath/declaration filed with this application does not specify how the scope of the original claims is different from the scope of the amended or added claims in this reissue application.

4. **Claims 35-72** are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

5. **Claims 35-72** are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue)

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relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The limitation “projecting from said drive shaft” in Amendment A of the patented file was included to Claim 1 in order to overcome a rejection to the claims. It was stated in page 8, lines 3-10 of Amendment A of the patented file: “The rejection of Claims 1-4, 8, 12, 14, 15 and 18... are deemed moot in light of the above amendments to the claims”. Applicant amended claim 1 to include the “projected from” limitation in order to overcome a prior art reference (see again page 8, lines 3-10 of amendment A of patented file) and therefore surrendered claims without “projecting from” in order to secure issuance of the patent and therefore subject matter may not be recaptured.

“To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments or changes to the claims made in an effort to overcome a prior art rejection.” See *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25, *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

Supplemental Declaration

6. In view of the amendments filed 4/18/2001, paper #3, a supplemental declaration complying with 37 CFR 1.175(b) is required in response to this office action.

Original Patent

7. Although assignee has agreed to surrender the original patent, the assignee must also file a certificate under 37 C.F.R. 3.73(b).

Preliminary Amendment

8. The preliminary amendment filed 4/18/2001 is improper because the requested change to the specification was not underlined (see page 2, section 11 of the preliminary amendment filed 4/18/2001). A new amendment showing the changes to the specification underlined is required in response to this office action.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. **Claims 35-72** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure does not have support for having a "draft shaft".

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11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. **Claims 35-67, 70, and 72** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites "said draft shaft" in lines 8 and 11 which lack proper antecedent basis.

Claim 37 recites "said draft shaft" in line 2 which lacks proper antecedent basis.

Claim 52 recites "said drive shaft" in lines 6 and 8 which lack proper antecedent basis.

Claim 60 recites "said seal member" in line 1 which lacks proper antecedent basis.

Claim 62 recites "said conveyor plate" in line 2 which lacks proper antecedent basis.

Claim 63 recites "said pin" in line 2 which lacks proper antecedent basis.

Claim 70 recites "the at least two openings" in line 3 which lacks proper antecedent basis.

Claim 70 recites "said at least two conveyors" in lines 6 and 8 which lack proper antecedent basis.

Claim 72 recites "the two workpieces" in lines 3 and 7 which lack proper antecedent basis.

Claim 72 recites "the adjacent openings" in line 8 which lack proper antecedent basis.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. **Claims 35-45, 49, 50, 52-60, 62, 64, 66, and 68-72** are rejected under 35 U.S.C. 102(b) as being anticipated by Schertler (3,915,117).

Schertler teaches the following in *Fig. 1-2*: a vacuum process apparatus (col. 1, lines 42-43) for processing at least one workpiece (col. 2, line 42), comprising a chamber **2** with two openings **15 and 16** defining respective opening areas (col. 3, lines 51-52 and col. 3, lines 15-16), and a transport device **3** (col. 2, line 35) having a drive shaft **4** (col. 2, line 54) rotatable around a rotational axis (see arrow close to **4**) of the drive shaft **4**, two conveyors **9 and 5** (see fig. 2) for at least one workpiece each, and a transport arm **24** for each conveyor **9 and 5** mounted opposite each other (see fig. 1) to the drive shaft **4** via **1**, the arms **24** being operatively coupled to the conveyors **9 and 5** to move the conveyors **9 and 5** independently of each other relative to the drive shaft **4**.

Note that the openings **15 and 16** define an opening area each, with normals on the openings **15 and 16** being rectangularly arranged with respect to the rotational axis (see arrow close to **4**), the conveyors **9 and 5** are moveable normally **52 and 54** with respect to the drive shaft **4**, the conveyors **9 and 5**, once positioned adjacent one of the openings **15 and 16** by rotation of the transport device **3**, are movable towards and from **52 and 54** the opening **15 and 16** in a normal direction of the opening areas **15 and 16**, the rotation of the transport device **3** around the rotational axis (see arrow close to **4**) substantially define a cone-shaped trajectory surface with a cone opening angle with respect to the rotational axis of 90 degrees, the openings

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15 and 16 defines an opening area, with normals on the opening areas pointing in a direction of respective generatrix of the cone-shaped trajectory surface, the openings **15 and 16** are arranged along a circle cut by the cone-shaped trajectory surface by a geometric plane arranged perpendicularly to the rotational axis (see arrow close to **4**), the transport device **3** residing within the chamber **2** further comprising a load lock chamber **21** and a treating station **22** communicating by one of the openings **16** with the chamber **21**, gas inlet means and pumping means (col. 3, lines 30-39) at least at one of the station **22** and chamber **21**, the conveyors **9 and 5** comprise a seal member **23** for sealingly closing one of the openings **16** when the conveyors **9 and 5** are rotated adjacent to the openings **16 and 15** by the transport device **3**, the seal member **23** is formed by a conveyor plate for the workpieces, the conveyor **9 and 5** comprises a conveyor plate **9**, and the two conveyors **5 and 9** are linearly movable **52 and 54** towards and from the axis by respective drives provided at the respective arms **24**.

With respect to Claims 49 and 64, the workpiece being one of a compact disk workpieces and of magneto-optical storage disk workpieces do not further limit the structure of the claimed apparatus and has not been given patentable weight.

With respect to Claim 52, Schertler teaches a vacuum chamber **2** for processing at least one workpiece, comprising two openings **15 and 16** defining respective opening areas, a transport device **3** with a draft shaft **4** for rotating the transport device **3** around a rotational axis (see arrow close to **4**) of the draft shaft **4**, two conveyors **9 and 5** and a transport arm **24** for each conveyor **9 and 5** mounted opposite each other to the drive shaft **4** via **1** and each being operatively coupled to one of the conveyors **9 and 5** to move the conveyors independently of each other relative to the drive shaft **4**.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 46-48, 61, 63, and 65** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schertler in view of Lavinsky et al. (5,126,992).

Schertler teaches the invention cited above with the exception of the conveyor plate having a projecting positioning pin.

Lavinsky et al. teach a positioning pin **22** for positioning a disk shaped workpiece **12** with a central bore.

It would have been obvious to one of ordinary skill in the art, at the time of the invention to have provided the invention of Schertler with the conveyor plate having a projecting positioning pin, in light of the teachings of Lavinsky et al., in order to securely hold a substrate having a central bore during processing operations.

Note that Lavinsky et al. teach holding means **58** for the workpiece formed by spring means **82** acting radially with respect to the pin **22**.

17. **Claims 51 and 67** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schertler.

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Schertler teaches the invention cited above with the exception of the drives being encapsulated by bellows.

Official notice is taken that it is well known in the art to use bellows to protect drive arms.

18. **Claims 35-47, 49-64, and 66-72** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boys et al. (4,795,299) in view of Mink (4,492,512).

Boys et al. teach the following in *Fig. 1*: a chamber **19** with two openings **21** and **27** defining respective opening areas, and a transport device **49** having a drive shaft **39** rotatable around a rotational axis of the drive shaft **39**, two conveyors **55** for at least one workpiece each, and a transport arm **53** for each conveyor **55** mounted opposite each other to the drive shaft **39**, the arms **53** being operatively coupled to the conveyors **55**.

Boys et al. teach the invention cited above with the exception of the conveyors moving independently of each other relative to the drive shaft.

Mink teaches conveyors **18** movable independently of each other relative to the drive shaft **78**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Boys et al. with the conveyors moving independently of each other relative to the drive shaft, in light of the teachings of Mink, in order to provide better independent control of each conveyor.

With respect to Claim 43, official notice is taken that it is well known in the art to have gas inlet and pumping means in processing stations.

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With respect to Claim 49 and 64, the particulars of the workpiece do not further limit the structural limitations of the claimed device and therefore lends no patentable weight to the claimed device.

With respect to Claims 51 and 67, official notice is taken that it is well known in the art to use bellows to protect drive arms.

Contact Information


19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (703) 306-5965. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5648.

MJ

September 26, 2001


S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a)

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.